

ALLOWANCE FROM

10/762,048

PARENT

parent 10/161,871

Notice of Allowability	Application No.	Applicant(s)	
	10/161,871	ARTHUR, SAMUEL DAVID	
	Examiner	Art Unit	
	Robert Sellers	1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☐ This communication is responsive to _____.
2. ☒ The allowed claim(s) is/are 1-14 and 16.
3. ☐ The drawings filed on _____ are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
- * Certified copies not received: _____.
5. ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 - (a) ☐ The translation of the foreign language provisional application has been received.
6. ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application. **THIS THREE-MONTH PERIOD IS NOT EXTENDABLE**

7. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
8. ☐ CORRECTED DRAWINGS must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No. _____.
 - (b) ☐ including changes required by the proposed drawing correction filed _____, which has been approved by the Examiner.
 - (c) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No. _____.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet.

9. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|---|--|
| 1 <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 2 <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3 <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 4 <input checked="" type="checkbox"/> Interview Summary (PTO-413), Paper No. <u>1003</u> . |
| 5 <input checked="" type="checkbox"/> Information Disclosure Statements (PTO-1449), Paper No. <u>9/02</u> . | 6 <input checked="" type="checkbox"/> Examiner's Amendment/Comment |
| 7 <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit of Biological Material | 8 <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9 <input type="checkbox"/> Other |

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-14, 16 and 17, drawn to a process for preparing a coating, classified in class 525, subclass 119.
- II. Claims 15 and 20, drawn to a coated article, classified in class 428, subclass 413.
- III. Claims 18 and 19, drawn to a cured coating, classified in class 525, subclass 438.

The inventions are distinct, each from the other because:

Inventions I and III are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product as claimed can be made by another and materially different process such as the preparation of the powder without exposure to an amine.

Invention I involves the preparation of a powder coating which is materially different from Invention II directed to a coated article since the coated article requires the further step of applying the powder coating to a substrate and curing it.

Inventions III and II are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful as an adhesive formulation and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

This application contains claims directed to the following patentably distinct species of the claimed invention:

- 1) The carboxyl-functional polymers of claim 2.

2) The polyepoxy compounds such as the bisphenol A epoxy resin of Resin Powders Gray #1 and Clear #3 shown on page 8, lines 5-8 and 11-12, respectively, of the specification.

3) The amines such as the ammonia of claim 7 or triethylamine of claim 9.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-20 are generic.

A reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

During a telephone conversation with John A. Langworthy on September 12, 2003 a provisional election was made with traverse to prosecute the invention of Group I, a carboxyl-functional polyester, a bisphenol A polyepoxy compound and gaseous ammonia as the amine, claims 1-14, 16 and 17. Affirmation of this election must be made by applicant in replying to this Office action. Claims 15 and 18-20 are withdrawn from further consideration under 37 CFR 1.142(b) as being drawn to non-elected inventions. Claims 8 and 9 are withdrawn as being directed to non-elected species of amine.

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with John A. Langworthy on October 17, 2003.

Claim 1, line 3, replace "chosen" with --selected--.

Claim 5, last line, replace "or" with --, and--.

Claim 16, line 3, after "that is" insert - -a non-ionic nitrogen-containing compound--.

Cancel claims 15 and 17-20.

Replace the title with: - -EXPOSING CARBOXYL POLYMER-POLYEPOXIDE POWDER TO AMINE FOR POWDER COATING--.

The following is an examiner's statement of reasons for allowance:

The closest prior art to Japanese Patent No. 9-279058 discloses the treatment of an epoxy-polyester composite resin to a quaternary ammonium compound to form a powder coating. Independent claim 1 is limited to treatment with an amine selected from the group consisting of organic amines and ammonia. Newly amended claim 16 is limited to exposure with a non-ionic nitrogen-containing compound as a catalyst (specification, page 7, lines 9-11). The specific amine of claim 1 and the non-ionic denotation of claim 16 precludes the ionic quaternary ammonium compound of the patent.

Japanese Patent No. 50-85632 sets forth the treatment of a polyepoxide and epoxy and carboxyl groups-containing polymer with ammonia prior to melt mixing and formulation of a powder coating. The claims require the exposure after the powder is prepared.

Japanese Patent No. 6-329955 shows a cured powder coating prepared from an epoxy resin, a carboxyl-functional acrylic rubber and 2-ethyl-4-methyl-imidazole which is pertinent to claim 18 directed to a non-elected invention.

Gross et al. and Noda et al. are directed to aqueous coatings wherein a carboxyl groups-containing polyester and epoxy resin are neutralized with an amine or ammonia to render them water-dispersible. The claims require the treatment of a powder of the polyester and epoxy resin as opposed to the claimed water-diluted mixture.

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European Patent No. 136,263 and Great Britain Patent No. 2,312,897 are drawn to powder coatings of carboxyl-functional polyesters and epoxy resins cured in the presence of an amine catalyst.

The claimed processes wherein the polymers are exposed to an amine or ammonia (claim 1), or a non-ionic nitrogen-containing compound (claim 16) in powder form prior to curing is not recited.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

(703) 308-2399 (Fax no. (703) 872-9306)
Monday to Friday from 9:30 to 6:00 EST



Robert Sellers
Primary Examiner
Art Unit 1712

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10/14/03